

REMARKS

By this Amendment, Applicants amend claims 1, 15, and 19. Claims 1-4, 7, and 9-21 remain pending in this application.

In the Final Office Action,¹ the Examiner rejected claims 1-4 and 7, and 9-21 under 35 U.S.C. § 103(a) as unpatentable over Saylor et al. (U.S. Patent No. 5,487,139) in view of Bell (U.S. Patent No. 5,422,989) and in further view of Moore et al. (U.S. Patent No. 6,377,210). Applicants respectfully traverse the rejection for at least the following reasons.

To establish a proper *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must demonstrate each of three requirements. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. See M.P.E.P. § 2143.01 (8th ed. 2001). Third, a reasonable expectation of success must exist. See M.P.E.P. § 2143.02 (8th ed. 2001). Moreover, each of these requirements must be found in the prior art, not in applicant's disclosure. See M.P.E.P. § 2143 (8th ed. 2001).

Claim 1 recites a method for simultaneously annotating a plurality of maps using a data processing system including, among other steps, "electronically and automatically adding a second annotation to the second map at the determined

¹ The Final Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Final Office Action.

geographic region when the first annotation is made on the first map.” Saylor, Bell, and Moore, whether taken individually or in combination, do not disclose or suggest at least this element of claim 1.

In the Final Office Action, the Examiner contends “Saylor also teaches adding the second annotation by posting an event marker at an appropriate location on the appropriate map, adding a marker, a colored pin for the interruptions/disturbances, the aligned territory on the raster and/or vector map, etc. to the second map” (emphasis in original). See page 4. Applicants respectfully disagree. As amended, claim 1 recites “electronically and automatically adding a second annotation to the second map at the determined geographic region when the first annotation is made on the first map” (emphasis added). Saylor does not teach or suggest at least this element of claim 1.

As the Examiner acknowledges, according to Saylor, the colored pin for interruptions/disturbances are manually added to a map. Therefore, Saylor does not teach at least the above element of claim 1 for at least this reason.

Furthermore, Saylor does not teach or suggest “electronically and automatically adding a second annotation to the second map at the determined geographic region when the first annotation is made on the first map,” as recited in claim 1 (emphasis added). In that regard, Applicants refer the Examiner to Applicants’ specification, which discloses that, once the user annotates a first map, a corresponding annotation automatically appears on the second map so that “it appears that the user is annotating both maps in synchronicity.” See specification² at page 10, lines 15-29. By contrast,

² In making reference to the specification, it is to be understood that Applicants are in no way intending to limit the scope of the claims to the exemplary embodiments described in the specification. Rather, Applicants expressly affirm that they are entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation and applicable case law.

Saylor requires “raster scanned images and the vector maps generated from the vector background database (TIGER) [to be] overlayed and aligned” in order to determine a correspondence between the maps. See col. 5, lines 30-33. Furthermore, according to Saylor, once the maps are aligned, a marker may be manually added at a desired location. However, the Saylor system does not disclose or suggest “automatically adding a second annotation to the second map at the determined geographic region *when the first annotation is made on the first map,*” as recited in claim 1 (emphasis added).

Furthermore, Bell and Moore do not compensate for the deficiencies of Saylor. For example, the Examiner contends that Bell teaches “transforming the pixel locations of the spatial array of pixels to corresponding latitude and longitude coordinates on the terrestrial surface and inversely translating latitude and longitude coordinates of the map images to identify which pixels are to be mapped to the display screen.” See Final Office Action, page 6. Additionally, the Examiner contends that Moore teaches “Auto-Sync’ allowing multiple users to vive changes of the geographically referencing object on different displays.” See Final Office Action, page 7. Even if the Examiner’s allegations regarding Bell and Moore are correct, which Applicants dispute, Bell and Moore also do not disclose or suggest “electronically and automatically adding a second annotation to the second map at the determined geographic region when the first annotation is made on the first map,” as recited in claim 1. Accordingly, for at least the above reasons, Saylor, Bell, and Moore, whether taken individually or in combination, do not disclose or suggest all this element of claim 1. Therefore, a *prima facie* case of

obviousness has not been established with respect to claim 1 and the rejection under 35 U.S.C. § 103(a) should be withdrawn.

Moreover, the Examiner has not demonstrated any motivation to combine Saylor, Bell, and Moore in a manner that would result in the claimed invention. Accordingly, a *prima facie* case of obviousness has not been established for at least this additional reason. For example, the Saylor system uses a vector database to create a vector map that is aligned with a raster map produced from an existing hand-drawn map. See col. 4, lines 51-53. In particular, Saylor aligns the maps in order to locate an event, such as a service outage. See col. 1, lines 32-38. In a different system, Bell teaches processing multiple images of the same terrestrial area so that a user manipulate the images with respect to the ground elevation surface. See col. 3, lines 3-51. In yet another system, Moore discloses using a GPS receive in mobile equipment that is attached to a vehicle in order to obtain global position information of the vehicle, which is transmitted through a communication network. See Abstract. Accordingly, the applied references are directed toward differing goals and techniques, i.e., Saylor teaches map alignment for purposes of locating a disturbance, while Bell provides a user with the ability to manipulate images based on ground elevation surface and, still further, Moore teaches GPS tracking of an object.

Applicants respectfully point out to the Examiner it "is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." See In re Wesslau, 147 U.S.P.Q. 391 (C.C.P.A. 1965). See also M.P.E.P. § 2141.02, p.

2100-120. “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” M.P.E.P. § 2143.01, p. 2100-124, *citing In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). In that regard, the present invention, as recited in independent claim 1, cannot be attained based merely on the combination of the applied references. One skilled in the art would only arrive at the present claimed invention by consulting Applicant’s disclosure. In particular, the only way to construct the claimed invention from the cited references would be to rely on aspects related to the present invention. Such reliance, however, would constitute improper hindsight reasoning. Thus, Applicants submit that Saylor, Bell, and Moore, individually or in combination, do not suggest the desirability of any modification to result in Applicant’s claimed invention, and these references do not show that there would be any reasonable expectation of success from so doing.

Furthermore, there is no suggestion or motivation to modify Saylor with Bell and Moore to produce Applicant’s claimed invention, and such combination would not be appropriate or effective. For example, at most, a combination of Saylor, Bell, and Moore would provide alignment of maps, the ability to navigate maps based on ground surface elevation, and the ability to track objects via GPS. However, such a combination would nevertheless fail to disclose or suggest Applicants’ claimed method for simultaneously annotating maps, which includes a step of “electronically and automatically adding a second annotation to the second map at the determined geographic region when the first annotation is made on the first map,” as recited in claim 1.

For at least the above additional reasons, a *prima facie* case of obviousness has not been established with respect to claim 1. Therefore, the rejection of claim 1 under 35 U.S.C. § 103(a) should be withdrawn.

Independent claims 15 and 19, while of a different scope from claim 1 and each other, include similar recitations as claim 1. For at least the reasons as discussed above, Saylor, Bell, and Moore, individually or in combination, also fail to disclose or suggest claims 15 and 19. Therefore, Applicants respectfully request the Examiner to allow claims 15 and 19.

Claims 2-4, 7, 9-14, and 21 depend from claim 1. Claims 16-18 depend from claim 15, and claim 20 depends from claim 19. Since Saylor Bell, and Moore, individually or in combination, fail to disclose or suggest every element of independent claims 1, 15, and 19, these references also fail to disclose or suggest every element of claims 2-4, 7, 9-14, and 21. Therefore, Applicants respectfully request the Examiner to allow claims 2-4, 7, 9-14, 16-18, 20, and 21.

CONCLUSION

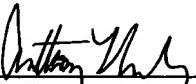
In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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